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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,949	07/24/2001	Thomas Louis Russo		5696

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Thomas Louis Russo  
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Rutland, VT 05701

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

9

DATE MAILED: 11/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/911,949

Applicant(s)

RUSSO, THOMAS LOUIS

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s): \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “adapted to” in claims 1, 2 and 4 is unclear, which render the claims vague and indefinite. The phrase “adapted to” is not a positive limitation on the claim. The article only has to be capable of being re-inflated.

The phrase “said pad further comprising said entry/exit portal tube passageway” in claims 1 and 4 is unclear, which render the claims vague and indefinite. It is unclear from the claim language if there are two separate and distinct entry/exit portals, or if there is only one portal wherein the portal is configured to permit re-inflating.

Correction/clarification is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Jaszai (USPN 5,826,723).

Jaszai discloses two flexible wall members, film (Column 12, lines 7 – 10), placed next to each other and sealed together through heat-sealing along the perimeters and through the internal area making two separate inflatable areas (Column 4, lines 1 – 7 and Figure 20, #14) which form an impact resistant wrapping, packing, system (Column 3, line 63). The wrapping system contains an intake tap for each of the separated inflatable areas (Column 7, lines 36 – 38 and Figure 20, #3). Each area is inflated or deflated independently through intake and exhaust taps located in the perimeter of the article (Figure 20, #3 and 5), allowing the wrapping system to be reused (Column 2, lines 22 – 25). The areas have also been adapted to redistribute the air through the formed chambers when pressure has been applied to the chambers (Column 7, lines 41 – 47).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jaszai.

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Jaszai discloses the claimed wrapping system above including the chambers maximizing available pad surface (Figure 20, #14); however, Jaszai fails to disclose the chambers being substantially conical in shape.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (Claim was directed to an advertising display device comprising a bottle and a hollow member in the shape of a human figure from the waist up which was adapted to fit over and cover the neck of the bottle, wherein the hollow member and the bottle together give the impression of a human body. Appellant argued that certain limitations in the upper part of the body, including the arrangement of the arms, were not taught by the prior art. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.) Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.) In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape which would have been unforeseen to one of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the chambers of the inflatable packing pad.

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One skilled in the art would have been motivated to do so in order to use the entire inflatable space formed when the two pieces are sealed together.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Magid (USPN 4,629,433).

Magid discloses a central wall member made from film (Column 4, lines 52 – 54), where individual sheets of plastic are placed next to each other and sealed to the central layer (Column 4, lines 54 – 56), forming a first layer through heat-sealing along the perimeters (Column 4, lines 30 – 33) making separate inflatable areas (Figure 4, #22 and Column 4, lines 54 – 56) which form an impact resistant wrapping, packing, system. The inflatable article contains an intake tap for each of the separated inflatable areas (Column 4, line 56 and Figure 4, #23). Each area is inflated or deflated independently through intake and exhaust taps located in the perimeter of the article (Figure 4, #23), allowing the wrapping system to be reused (Column 6, lines 60 – 65). However, Magid fails to disclose a second layer on the opposite side of the central layer to form at least four separate areas within the inner pad volume.

Magid discloses the claimed invention except for a second layer on the opposite of the first layer which formed separate areas on the pad surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place individual sheets of plastic material on the opposite side of the central layer which are sealed to the central layer to form inflatable areas having their own valve control on the surface of the article, since it has

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been held that mere duplication of the essential working parts of an article involves only routine skill in the art. *St. Regis Co. v. Bemis Co.*, 193 USPQ 8.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 4,465,188 to Soroka et al. is cited to show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

pln

November 1, 2002

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

11/1/02